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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,416	02/20/2004	Randal T. Byrum	END-5084NP	1876
27777	7590	12/01/2006	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			REIMERS, ANNETTE R	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/784,416

Applicant(s)

BYRUM, RANDAL T.

Examiner

Annette R. Reimers

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

It is noted that full faith and credit is being given to the action by the previous Examiner in accordance with MPEP 706.04.

### ***Specification***

The abstract of the disclosure is objected to because it contains implied language, i.e. "the present invention." Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

Claim 1 objected to because of the following informalities: It appears that the word "shape" was inadvertently removed from line 7 of claim 1. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 86/04498 to Hallberg.

Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hallberg discloses an implantable surgical device having a deployed shape and an undeployed shape, the device comprising: an elongated flexible inflatable portion (4); and an elongated flexible and substantially inextensible band portion (7) having a distal end, a proximal end and a longitudinal axis therebetween, the band portion being attached to the inflatable portion along an inner face thereof (FIG. 1), wherein the inflatable portion and the band portion are integrally manufactured as one part (page 3, lines 25-26); wherein the band portion in its deployed shape has a substantially flat cross section (Page 3, lines 20-23), taken perpendicular to the longitudinal axis; wherein the band portion is at least partially made from at least one of silicone and polyurethane (Page 4, lines 12-17); further comprising a means for attaching the distal and proximal ends of the band together (; an injection port (6) in fluid communication with the inflatable portion.

Hallberg discloses the claimed invention except wherein when the device is in its undeployed shape the band portion has a concave cross section along a majority of its longitudinal axis, taken perpendicular to the longitudinal axis. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the device of Hallberg wherein when the device is in its undeployed shape the band portion can have a concave cross section along a majority of its longitudinal axis, taken perpendicular to the longitudinal axis, since it is just one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of creating a flexible band. *In re Dailey and Eilers*, 149 USPQ 47 (1966). Furthermore, since the band is flexible, it would be obvious that the band would have a concave or convex shape depending on how the band was grasped by the user.

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Hallberg, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claims 1-3, 5-7, 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,601,604 to Vincent.

Vincent discloses an implantable surgical device having a deployed shape and an undeployed shape, the device comprising: an elongated flexible inflatable portion (16); and an elongated flexible and substantially inextensible band portion (11) having a distal end, a proximal end and a longitudinal axis therebetween, the band portion being attached to the inflatable portion along an inner face thereof (FIG. 1), wherein the inflatable portion and the band portion are integrally manufactured as one part (Column 3, lines 2-5) wherein the band portion in its deployed shape has a substantially flat cross section (FIG. 2), taken perpendicular to the longitudinal axis; further comprising a means for attaching the distal and proximal ends of the band together (13, 19); an injection port (14) in fluid communication with the inflatable portion.

Vincent discloses the claimed invention except wherein when the device is in its undeployed shape the band portion has a concave cross section along a majority of its longitudinal axis, taken perpendicular to the longitudinal axis. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the device of Vincent wherein when the device is in its undeployed shape the band portion can have a concave cross section along a majority of its longitudinal axis, taken perpendicular to the longitudinal axis, since it is just one of numerous shapes or configurations a person of ordinary skill in the art would find obvious for the purpose of creating a flexible band. In re Dailey and Eilers, 149 USPQ 47 (1966). Furthermore, since the band is flexible, it would be obvious that the band

would have a concave or convex shape depending on how the band was grasped by the user.

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Vincent, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-13 have been considered, but are moot in view of applicant's amendments to the claims, which have resulted in the new ground(s) of rejection.

In addition, examiner respectfully disagrees with applicant regarding both references. The band portion (7) of the Hallberg reference taken in cross section would indicate that when the device is in its undeployed shape the band portion has a concave cross section along a majority of its longitudinal axis, taken perpendicular to the longitudinal axis (see the concavity, i.e. the curving in, of the band portion (7) in figure 1). Moreover, the band portion (11) of the Vincent reference taken in cross section would indicate that when the device is in its undeployed shape the band portion has a concave cross section along a majority of its longitudinal axis, taken perpendicular to the longitudinal axis (see the concavity, i.e. the curving in, of the band portion (11) in

figure 1). Furthermore, as stated above, since the bands of both references are flexible, it would be obvious that the band would have a concave or convex shape depending on how the band was grasped by the user.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER